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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,920	03/30/2001	Samuel Daniel Dull III	ROC920010099US1	7671

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03/25/2005

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EXAMINER

FOWLKES, ANDRE R

ART UNIT

PAPER NUMBER

2192

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/821,920	<b>Applicant(s)</b> DULL ET AL.	
	<b>Examiner</b> Andre R. Fowlkes	<b>Art Unit</b> 2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 [1-5 and 7-25] is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 [1-5 and 7-25] is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/25/01</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-24 [1-5 and 7-25] are pending.

***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

In order to account for missing claim 6, misnumbered claims 7-25 been renumbered 6-24.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19 [20] and 21 [22] recite the limitation "the upgrade object". There is insufficient antecedent basis for this limitation in the claim. The examiner is interpreting "the upgrade object" as --the installation object--.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 16 [17] is directed to non-statutory subject matter. Claim 16 [17] recites a signal bearing media, embodied on a computer program product, incorporating the same limitations as recited in claim 1. However, applicant states that "examples of suitable signal bearing media include ... CD-ROM, DVD, and transmission type media, such as digital and analog communications links", on p. 12:20-13:1. Transmission type media are merely electrical, electromagnetic or optical signals, which are transient in nature and thus are neither concrete, tangible nor are they a permanent medium upon which to embody the claimed invention. Since the claims must be given their broadest reasonable interpretation, the invention as claimed reads on both statutory and non-statutory subject matter. Claims that are broad enough to read on both statutory and non-statutory subject matter are considered non-statutory.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5 and 6-24 [7-25] are rejected under 35 U.S.C. 102(b) as being anticipated by London Shrader et al., (Shrader), U.S. Patent No. 5,870,611.

As per claim 1, Shrader discloses **a method of upgrading a computer program on a computer system, the computer system including an instruction processing program**, (col. 1:18-21, " This invention relates generally to electronic distribution of software in computer networks. More particularly, the invention relates to defining and constructing a proposed plan object for installing the software on the network"), **the method comprising:**

- **receiving an upgrade object associated with the computer program** (col. 1:20-21, " the invention relates to defining and constructing a proposed plan object (i.e. upgrade object) for installing the software on the network""),

- **the upgrade object including an instruction set adapted for use by the instruction processing program** (col. 4:17-18, " The RAM 24 is the main memory into which the operating system (i.e. instruction processing program) and application programs (i.e. upgrade object) are loaded", and col. 4:36-37, "One of the preferred implementations of the invention (i.e. the upgrade object) is as sets of instructions resident on the random access memory"),

- **and executing the instruction set with the instruction processing program** (col. 4:17-18, " The RAM 24 is the main memory into which the operating system (i.e. instruction processing program) and application programs (i.e. instruction sets) are loaded", and col. 4:36-37, "One of the preferred implementation s of the invention is as sets of instructions resident on the random access memory").

As per claim 2, the rejection of claim 1 is incorporated and further, Shrader discloses **instructing the instruction processing program to execute the instruction set** (col. 4:17-18, "The RAM 24 is the main memory into which the operating system (i.e. instruction processing program) and application programs (i.e. instruction sets) are loaded", and col. 4:36-37, "One of the preferred implementations of the invention is as sets of instructions resident on the random access memory").

As per claim 3, the rejection of claim 1 is incorporated and further, Shrader discloses that **the upgrade object is associated with one or more prerequisites; and further comprising determining if the one or more prerequisites have been met** (col. 5:60-62, "An important aspect of the invention is that the install plan object (i.e. upgrade object) and its subcomponents are implemented in an object oriented system", and col. 5:34-39, "An LCU command file (i.e. an upgrade object attribute) identifies ... the order in which the products should be installed or configured (i.e. prerequisites)").

As per claim 4, the rejection of claim 1 is incorporated and further, Shrader discloses **reporting that the instruction set has been executed** (col. 6:60-62, "The network information tool 66 is used to determine (and report) the status of a committed plan object (i.e. installation/upgrade instruction sets)").

As per claim 5, the rejection of claim 1 is incorporated and further, Shrader discloses that **the upgrade object is suitable for transmission by electronic mail**

(col. 5:22-25, "one or more machines in the network as a code server from which other workstations in the network receive the computer software").

As per claim 6 [7], the rejection of claim 1 is incorporated and further, Shrader discloses that **the instruction set comprises binary instructions** (col. 9:20, "Install Scripts (i.e. binary instructions)").

As per claim 7 [8], the rejection of claim 1 is incorporated and further, Shrader discloses that **the instruction set comprises a script** (col. 9:20, "Install Scripts").

As per claim 8 [9], the rejection of claim 7 [8] is incorporated and further, Shrader discloses that **the instruction processing program is adapted to compile and execute the script** (col. 9:20, "Install Scripts (are executed)").

As per claim 9 [10], the rejection of claim 1 is incorporated and further, Shrader discloses that **the upgrade object requires the instruction processing program to be executed by the computer system** (col. 9:57-10:5, "The code server container object (i.e. instruction processing program) may contain one or more code server objects 350. FIG. 6 depicts the code server container object 62 with a code server object 350 and an application image object 400. The code server object represents a physical file server machine which store the application images and which is to be accessed by client workstations during an installation, configuration, reinstall or removal

of application software. The code server also contains directories to the various command and response files needed to perform the remote installation. The Code Server object 350 encapsulates the data and methods needed to discover where installable code images are located and to build network file system attach commands for those code images (i.e. upgrade object). It can also be used to store generated response files and output log files. It is a container for application images").

As per claim 10 [11], the rejection of claim 1 is incorporated and further, Shrader discloses that **the upgrade object is not independently executable** (col. 9:57-10:5, "The code server container object (i.e. instruction processing program) may contain one or more code server objects ... The Code Server object 350 encapsulates (i.e. is needed to execute) the data and methods needed to discover where installable code images are located and to build network file system attach commands for those code images (i.e. upgrade object). It can also be used to store generated response files and output log files. It is a container for application images").

As per claims 11-14 [12-15], this is another method version of the claimed method discussed above, in claims 2, 4, 8 [9] and 10 [11], wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see Shrader's install plan object for network installation of application programs (col. 1:18-9:65).



As per claim 15 [16], this is another method version of the claimed method discussed above, in claims 3, 4 and 8 [9], wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see Shrader's install plan object for network installation of application programs (col. 1:18-9:65).

As per claim 16 [17], this is a product version of the claimed method discussed above, in claim 1, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see Shrader's install plan object for network installation of application programs (col. 1:18-9:65).

As per claims 17-21 [18-22], this is another method version of the claimed method discussed above, in claims 3-5, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see Shrader's install plan object for network installation of application programs (col. 1:18-9:65).

As per claims 22-24 [23-25], this is another method version of the claimed method discussed above, in claims 4, 5 and 11, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see Shrader's install plan object for network installation of application programs (col. 1:18-9:65).

### ***Conclusion***

Art Unit: 2122

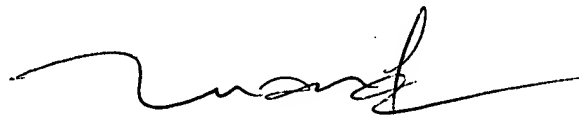
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre R. Fowlkes whose telephone number is (571) 272-3697. The examiner can normally be reached on Monday - Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571)272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: 571-272-2100**.

ARF



TUAN DAM  
SUPERVISORY PATENT EXAMINER